

Serial No.: 09/942,977

REMARKS

Claims 1 and 3-20 are pending in the present application. Claims 1 and 11 are amended to correct typographic errors and/or clarify the subject matter recited therein. No new matter is added. In view of the following remarks, favorable reconsideration of this case is respectfully requested.

Claims 1, 3-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,892,900 to Ginter et al. (hereafter Ginter). Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter. Applicants respectfully traverse.

Independent claim 1 relates to a method executed in a computer system for monitoring a utilization condition of contents, wherein the computer system is provided on a network to which a user terminal is allowed to connect, the user terminal carrying out information processing by utilizing the contents. The method of claim 1 includes, *inter alia*, embedding digital information in the contents, the *digital information itself causing the user terminal to automatically transmit a contents utilizing history* indicating a utilizing condition of the contents to the information gathering means at a predetermined timing.

In the present invention, the *digital information embedded in the contents causes a user terminal to automatically transmit a contents utilizing history*. The Examiner asserts on page 3 of the final Office Action that "embedding digital information in contents via container" and "VDE on client monitors content usage and reports usage history to server periodically" is described in Ginter. The Advisory Action on page 2 cites to Ginter, column 168, lines 10 to 13, as apparently suggesting that a user's electronic appliance 600 may communicate with a clearing house automatically. However, there is no indication in Ginter that digital information causes a user terminal to automatically transmit a contents utilizing history.

Serial No.: 09/942,977

In the present invention, the digital information is embedded in the contents and the digital information itself (as middleware, discussed in the specification; page 18, line 27, to page 19, line 17) causes the user terminal to automatically transmit a contents utilizing history. Therefore, in the present invention, the utilizing condition of contents can be monitored without eliminating the flexibility in operation of the user terminal (as discussed in the specification; page 23, line 12-30), and such monitoring can be modified for each content, since the digital information is embedded in each contents, and the digital information can be modified for each contents so that the monitoring is modified for each content.

Ginter discloses that electric appliance 600 may be a computer, a T.V. set-top control box, a pager, a telephone, a sound system, a video reproduction system, a video game player, a smart credit card, and may include a keyboard, keypad, voice recognizer, and display (Ginter; col. 60, line 59 to col. 61, line 5). The Examiner asserts that Ginter discloses the recited automatic transmission at column 168, lines 12-13 (Advisory Action; page 2, lines 16-18).

However, this section and the accompanying context states only that:

Typically, the *end user's electronic appliance 600 may initiate communications* with a clearinghouse (Block 1152). This contact may, for example, be *established automatically or in response to a user command*. It may be initiated across the electronic highway 108, or across other communications networks such as a LAN, WAN, two-way cable or using portable media exchange between electronic appliances.

(Ginter; col. 168, lines 9-15 ; emphasis added). In Ginter, means for causing (triggering) the electronic appliance 600 to transmit a contents utilizing history are apparently previously provided in the electronic appliance 600, or a user must input a command to cause the electronic appliance 600 to initiate the automatic communications. There is no disclosure, or suggestion, that *embedded digital information causes the user terminal to automatically transmit a*

Serial No.: 09/942,977

contents utilizing history. Ginter apparently discloses electronic appliance 600 initiating an automatic transmission. However, this does not equate to, disclose, or suggest, embedded digital information causing an automatic transmission.

In fact, in the section following the above-quoted section of Ginter, the user issues a request which causes the electronic appliance 600 to automatically contact the VDE administrator (Ginter, col. 168, lines 30-34). Apparently, in Ginter, contents or digital information in the contents *does not* cause electronic appliance 600 to contact the VDE administrator. Therefore, in Ginter, the monitoring does not suggest or disclose the feature of the present invention, i.e., "embedding digital information in said contents, said digital information itself causing said user terminal to automatically transmit a contents utilizing history".

In sharp contrast to the method of Ginter, Applicants' claimed method provides a means for embedding digital information within the distributed digital contents that is effective to cause a contents utilizing history to be prepared and transmitted by a user terminal receiving distributed contents (see, e.g., page 18, line 27 to page 19, line 30 of Applicants' specification). Applicants' claimed method based on embedded digital information ("middleware") enables content usage monitoring to be performed by a variety of user terminal platforms, without requiring the installation of a specific content management software as in the case of Ginter. Accordingly, Applicants respectfully submit that the method as taught in amended independent claim 1 is not anticipated by Ginter, and that amended independent claim 1 is therefore allowable.

The Examiner previously relied on several disclosures in Ginter relating to reporting usage information from a user clearinghouse. (Ginter, col. 18, lines 22-24; col. 33, lines 36-38; col. 36, lines 28-34; and col. 137, lines 7-10). These sections apparently relate to the metering of usage information of electronic content. However, none of the cited sections appear to disclose

Serial No.: 09/942,977

embedded digital information causing a user terminal to automatically transmit a contents utilizing history, as recited in the independent claims. The Office Action cites several additional sections of Ginter in support of the gathering step of claim 1, which includes the automatic transmission from the user terminal of contents utilizing history. However, none of these sections discuss or even suggest digital contents including digital information causing a user terminal to automatically transmit information to another system. For instance, flexible metering is apparently discussed (Ginter; col. 33, lines 36-65); updating a secure database is apparently discussed (Ginter; col. 168, lines 1-15); and storing an audit record is apparently discussed (Ginter; col. 188, lines 29-38). One section cited by the Examiner states:

“System-initiated” events are generally happenings not attributable to a user. Examples of system initiated events include the *expiration of a timer* indicating that information should be backed to non-volatile memory, *receipt of a message* from another electronic appliance 600, and a *service call generated* by another process (which may have been started to respond to a system-initiated event and/or a user-initiated event).

(Ginter; col. 176, lines 58-65; emphasis added). However, none of the system initiated events discussed in the quoted section of Ginter relate to *updating with contents utilizing history an information gathering means*. Therefore Ginter does not disclose or suggest this feature, and claim 1 is allowable at least for this additional reason.

As independent claims 6, 11, 13, 15, and 17 each include limitations providing for the generation of a contents utilizing history at a user terminal based by means of information embedded in the digital content distributed to the user terminal, and include limitations providing for gathering, according to digital information included in distributed contents, a contents utilizing history via an information gathering means which is automatically transmitted from the user terminal, Applicants reapply the above arguments in regard to claims 6, 11, 13, 15, and 17,

Serial No.: 09/942,977

and submit that claims 6, 11, 13, 15, and 17 are also allowable. As claims 3-5, 7-10, 12, 14, 16, and 18-20 each depend from one of allowable independents claims 1, 6, 11, 13, 15 and 17, Applicants respectfully submit that claims 3-5, 7-10, 12, 14, 16, and 18-20 are allowable for at least this reason.

CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



Brian E. Hennessey
Reg. No. 51,271

CUSTOMER NUMBER 026304

Telephone: (212) 940-6311

Fax: (212) 940-8986 or 8987

Docket No.: 100809-16280 (SCEW 18.970)

BEH:pm